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Attorney Docket No.: SP02-260

REMARKS

Applicants appreciate the courtesy shown by the Office, as evidenced by the April 26, 2007, Office Action. In that Office Action, the Examiner rejected Claims 1-6, 8-12, 14-24, and 26-31. Claims 7, 13, and 25 have been withdrawn from consideration and Claims 6 and 32-65 have been canceled. As such, Claims 1-5 and 7-31 remain in the case with none of the claims being allowed.

The April 26 Office Action has been carefully considered. After such consideration, Claims 1, 8, 9, and 31 have been amended and Claim 6 has been canceled, without prejudice. Applicants respectfully request reconsideration of the application in light of the accompanying amendment and the remarks presented herein.

Claims 1-6, 8-12, 14-24, and 26-31 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the transition phrase "consisting essentially of," added in the communication received by the Office on March 9, 2007, is new matter. Applicants submit that the transition phrase "consisting essentially of" has been deleted from Claims 1 and 31 in the present amendment, thus making the rejection under 35 U.S.C. §112, first paragraph, moot.

Claims 1-3 have been rejected under 35 U.S.C. §102(e) as being anticipated by Yano et al. (U.S. Patent 6,740,590).

Applicants submit that independent Claim 1 has been amended to recite a process in which a slurry comprising a plurality of multi-component particles is provided, wherein each of the multi-component particles is an abrasive species consisting of at least one $\alpha_x\beta_y$ composition, wherein α is a transition metal, a metalloid, an alkaline earth element, a rare earth element, an alkali element, or a combination of transition metals, metalloids, alkaline earth elements, rare earth elements, and alkali elements, and wherein β is at least one of O, F, and N, and x and $y \neq 0$. Support for the amendment is found, for example, in paragraph [0028] on pages 8 and 9 of the specification. Claims 8 and 9 have also been amended to provide proper antecedent basis.

Applicants submit that, in order to anticipate a claim, a reference must teach every aspect of the claimed invention. Accordingly, Applicants submit that Yano et al. do not

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teach providing a slurry comprising a plurality of multi-component particles, wherein each of the multi-component particles is an abrasive species consisting of at least one $\alpha_x\beta_y$ composition, wherein α is a transition metal, a metalloid, an alkaline earth element, a rare earth element, an alkali element, or a combination of transition metals, metalloids, alkaline earth elements, rare earth elements, and alkali elements, and wherein β is at least one of O, F, and N, and x and $y \neq 0$. Instead, the reference teaches a slurry containing polymer particles that are electrostatically bonded to inorganic particles composed of metal oxides. See, for example, the Abstract; FIG. 2; and column 1, lines 14-17, of Yano et al.

Applicants submit that, because the reference does not teach every aspect of amended independent Claim 1, the rejection of Claims 1-3 under 35 U.S.C. §102(e) as being anticipated by Yano et al. is successfully overcome.

Claims 4-6, 8-12, 14-24, and 26-31 have been rejected under 35 U.S.C. §103(a) as being obvious over Yano et al.

Claims 4-6, 8-12, 14-24, and 26-30 depend from independent Claim 1 and thus include the limitations of the base claim by reference. As previously presented, independent Claim 1 has been amended to overcome the rejection under 35 U.S.C. §102(e), and is now in condition for allowance. As Claim 1 is now allowable, the claims depending from this claim must also contain allowable subject matter. The rejection of Claims 4-6, 8-12, 14-24, and 26-30 under 35 U.S.C. §103(a) as being obvious over Yano et al. is therefore moot.

Claim 31 has been amended in part to recite a process in which a slurry comprising a plurality of multi-component particles is provided, wherein each of the multi-component particles is an abrasive species consisting of at least one $\alpha_x\beta_y$ composition, wherein α is a transition metal, a metalloid, an alkaline earth element, a rare earth element, an alkali element, or a combination of transition metals, metalloids, alkaline earth elements, rare earth elements, and alkali elements, and wherein β is at least one of O, F, and N, and x and $y \neq 0$.

In order to establish a *prima facie* case of obviousness, a reference must either teach or suggest all of the claimed limitations. Accordingly, Applicants submit that Yano et al. neither teach nor suggest all of the limitations of amended Claim 1. The reference does not teach or suggest providing a slurry comprising a plurality of multi-component

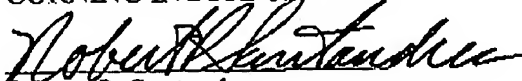
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particles, wherein each of the multi-component particles is an abrasive species consisting of at least one $\alpha_x\beta_y$ composition, wherein α is a transition metal, a metalloid, an alkaline earth element, a rare earth element, or an alkali element, or a combination of transition metals, metalloids, alkaline earth elements, rare earth elements, and alkali elements, and wherein β is at least one of O, F, and N, and x and $y \neq 0$. Yano et al. instead teach a slurry containing polymer particles electrostatically bonded to inorganic particles. Applicants submit that, by teaching the inclusion of polymer particles in the slurry, the reference actually teaches away from an abrasive slurry in which each of the multi-component particles is an abrasive species consisting of at least one $\alpha_x\beta_y$ composition.

Applicants therefore submit that, because the reference fails to teach or suggest all of the limitations of the claimed invention and teaches away from the claimed invention, the rejection of Claim 31 under 35 U.S.C. §103(a) as being obvious over Yano et al. is successfully overcome.

In light of the amendments and remarks presented herein, Applicants submit that the case is in condition for immediate allowance and respectfully request such action. If, however, any outstanding issues remain unresolved, the Examiner is invited to telephone the Applicants' counsel at (607) 974-2112.

Respectfully submitted,

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